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EXAMINER

YU, GINA C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/868,256
Filing Date: July 15, 2001
Appellant(s): TANAKA ET AL.

EILEEN L. HUGHETT
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 5, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,985,455	MONOTO	1-1991
JP HEI 4[1992]-48925)	SUMIDA	2-1992
JP 3-115208	SUGIZAKI	5-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sumida (English translation of Japanese Kokai application no. HEI 4[1992]-48925) in view of Motono (US 4985455), or alternatively, in view of Sugizaki (English translation of Japanese Kokai application no. 3-115208).

Sumida teaches transparent microemulsion composition comprising (a) 0.1-30.0wt % of nonionic surfactants which include polyoxyethylene castor oil or hardened castor oil derivatives; (b) 0.001-20 wt % of ionic surfactants which include polyoxyethylene alkyl ether phosphate; (c) 0.1-30wt % of oil; and (d) 40-99 wt % of water. See Translation, p. 2 – p. 6. Polyoxyethylene sorbitol tetraoleate is disclosed on p. 5, group 10. Example 1 on p. 8 shows the use of polyhydric alcohol. The types of oil and additives that may be used for the invention are also discussed. The reference further teaches that the preferred ratio of nonionic surfactant to oily substance is 1: 1-3, which meets instant claim 2. It teaches that at a high ratio of surfactant to oil the skin safety and feel are degraded. See p. 3, last paragraph. The reference further teaches that the preferred ratio of ionic surfactant to oil is 1:0.01-2.0. See p. 6, paragraph 3.

Although the specific ratio of each surfactants are not disclosed in the reference, examiner views that given the teachings of the preferred surfactants and their amounts in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.

While Sumida teaches that the disclosed ionic surfactants are used alone or in combination of two or more, the reference fails to provide particular formulation comprising polyoxyethylene sorbit tetraalkyl ester.

Motono teaches a clear cosmetic emulsion composition comprising POE sorbitol tetraoleate. See Example 2. See also Example 3.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of three conventional nonionic surfactants well known in cosmetic emulsion art. It would follow that the recited claims define prima facie obvious subject matter.

Sugizaki teaches a transparent cosmetic composition comprising polyoxyethylene sorbitol tetraoleic acid ester. The reference teaches that the composition has good emollient and moisturizing action, as well as good appearance, skin feel and stability. See Translation, p. 2, Detailed Description of the Invention.

Table 1 shows clear oily compositions comprising PEO (6) sorbitol tetraoleic esters and POE (11) hydrogenated castor oil.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the formulations in Sumida by adding polyoxyethylene sorbitol tetraoleate as motivated by Sugizaki because of the expectation of successfully producing a transparent cosmetic composition which provide long shelf-life as well as non-greasy feel and moisturizing effect on skin.

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (U.S. Pat. No. 5474776) ("Koyanagi") in view of Motono, or alternatively, in view of Sugizaki.

Koyanagi teaches transparent cosmetic composition comprising (a) hydrophilic nonionic surfactants which may include the surfactants of instant claim 8 (a); (b) liquid oil; (c) water-soluble compound which may include polyhydric alcohol; (d) water. See abstract; col. 2, line 23 – col. 6, line 27. The reference mentions polyoxyethylene sorbitan fatty acid ester and polyoxyethylene hardened castor oils are particularly preferred, and may teaches that the surfactants may be used singly or in combination, meeting instant claim 1. See col. 3, lines 33 – 37. Instant claim 9 is met by the disclosure of the types of oil used in the invention in col. 4, lines 50 – 67. The additives are disclosed in col. 6, lines 2 – 12, meeting instant claim 10. The reference further teaches that (a) 1-30 wt % of surfactants (b) 1-60 wt % of liquid oil; (c) 10-70 wt % of water-soluble compound; and (d) 1-87.99 wt % of water. See col. 3, line 38 - col. 5, line 7.

While Koyanagi discloses the use of POE tetraoleate in the composition, the reference fails to provide particular motivation select the ester.

Motono, discussed above, disclosed a clear oil-in-water emulsion cosmetic composition comprising a POE tetraoleate.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. See In re Kerkhoven. In this case, the concomitant use of two conventional nonionic surfactants well known in cosmetic art would have been obvious to a skilled artisan at the time the instant invention was made.

Sugizaki, discussed above, teaches that POE tetraoleate is used to formulate a clear oil based composition, and provides good emollient and moisturizing action, as well as good appearance, skin feel and stability. See Translation, p. 2,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition disclosed in Koyanagi by adding POE tetraoleate as motivated by Sugizaki, because of the expectation of successfully producing a cleansing composition with good emolliency, moisturizing properties, aesthetic qualities, good skin feel, and stability.

(11) Response to Argument

1. Claims 1, 2, and 4-10 were properly rejected under 35 U.S.C. § 103(a) over Sumida in view of Motono, or alternatively, in view of Sugizaki.

Examiner asserts that the rejection is proper since the claimed limitations are found in the collective teachings of the references, which are all directed to cosmetic art. The motivation to combine the teachings is also found in the references.

While applicants assert, "no motivation is provided to explore a combination of surfactants, which would solubilize the oil without the use of a microfluidizer", applicants' statement is erroneous because through out the reference the use of nonionic surfactants is taught, suggested, and demonstrated. In fact, the reference in entirety teaches the use of nonionic surfactants to formulate microemulsion. Whether a microfluidizer is used is not an issue in this case, since the claimed invention is a composition and not how it is made. Nevertheless, it is noted that applicants also utilize an equipment to homogenize the claimed composition: See Spec. p. 20, lines 1-7.

Applicants' assertion that POE tetraalkyl esters is absent from the Sumida reference is erroneous because, as indicated in the rejection, the reference teaches polyoxyethylene sorbitol tetraoleate on p. 5, group 10. Sumida merely fails to provide an example formulation comprising a polyoxyethylene sorbitan tetraalkyl ester. Thus, applicants' assertion that the reference fails to provide motivation to use the claimed combination of surfactants is incorrect.

While applicants argue that Sugizaki discloses "a water-on-oil composition having very low levels of water, 0.5% in all the examples shown in Table 1", applicants fail to consider the combined teachings of the Sumida and Sugizaki references. Applicants' claimed range of water in a microemulsion is well known in the art, as evidenced by Sumida. Sumida specifically teaches to use water in the range of 40-99 % of the total microemulsion. See p. 5, line 19. Sugizaki was cited to show that

polyoxyethylene sorbitol tetraoleate is known to provide long shelf-life as well as non-greasy feel and moisturizing effect on skin, which would have provided a skilled artisan sufficient motivation to employ the POE sorbitol tetraalkyl ester.

Contrary to applicants' arguments, POE sorbit tetraalkyl ester is taught in all three of the Sumida, Motono, and Sugizaki. Motono teaches a clear cosmetic formulation comprising the surfactant, and Sugizaki specifically teaches the advantages of using POE sorbitol tetraoleate in a cosmetic formulation. The motivation to combine the references is objectively found in the references.

2. Claims 8-10 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the Koyanagi in view of Motono, or alternatively, in view of Sugizaki.

Applicants assert, "the instant invention does not contemplate the addition of an amphoteric surfactant". The argument is unpersuasive because the instant claim is not limited to a composition containing only the recited components.

Applicants' statement that Koyanagi composition contain only 1-40 % of water is inconsistent with the actual teachings that 1-87.99 wt % of water is used. See col. 3, line 38 - col. 5, line 7. While applicants also assert that Tables 1-3 show preferred range of 5-15 % of water, it is well known in patent law that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. The court in In re Susi held that "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." See 440 F.2d 442, 169

U.S.P.Q. 423 (C.C.P.A. 1971). In this case, the broad disclosure of the water content of the composition meets the claimed limitation.

Applicants again argue that a routineer would not consider the components of Sugizaki because of the low content of water in the composition. Examiner respectfully disagrees. The claimed water content in a microemulsion is taught in Koyanagi, and Sugizaki was cited here because of the teachings of the specific advantages of polyoxyethylene sorbitol tetraoleate.


Examiner asserts that all the limitations of the present claims are met, and the rejections are properly made based on the objective evidences found in the cited references.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Gina Yu
June 23, 2004

Conferees


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